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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/455,806	12/07/1999	JOHN L. BEEZER	3797.84617	5592

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EXAMINER
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THAI, HANH B

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/455,806

Applicant(s)

BEEZER ET AL

Examiner

Hanh B Thai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on the amendment dated 7/16/2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

This is in response to the Amendment dated July 16, 2003.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement filed June 30, 2003 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the copies of "Foreign patent documents" and "non patent literature documents" on the information disclosure statement are not provided. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, it is not clear what "selected object" refer to. In the interest of compact prosecution, it is assumed that "the selected object" is a designation of an object.

### ***Claim Rejections - 35 USC § 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowe et al. (U.S. Patent no. 5,737,599) of record.

1. Regarding claims 9 and 19, Rowe discloses a computer-implemented method for annotating a system having a display for displaying a page having objects, the objects stored in a non-modifiable portion of a file, comprising the steps of:

- receiving a designation of an object of the objects on the displayed page (see col. 16, lines 61-67, Rowe);
- receiving an annotation (see col.34, lines 5-30, Rowe);
- determining a position of the object in the non-modifiable portion of the file (see col. 7, lines 8-16; col. 11, lines 5-7; col. 12, lines 60-63 and col. 36, lines 39-44, Rowe);
- storing the position and the annotation separately from the non-modifiable portion of the file (see col.12, lines 48-59, Rowe);

where the determining steps comprises the steps of:

- counting the number of bytes from the beginning of the non-modifiable portion of the file to a first object on the displayed page object (see col. 12, lines 60-63 and col. 36, lines 42-44, Rowe). An offset is a number (in bytes) that tells how far from a starting point a particular item is located by definition;

Rowe, however, does not explicitly disclose “counting the number of bytes from the first object” and “adding the number obtained from the first counting step to the number obtained from the second counting step to determine the file position of the object in the file”. But, Rowe discloses “the number of bytes from start of page to start of contents stream” and “added to the least start of contents offsets” (col.37, line 66 to col. 38, line 28, Rowe). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Rowe to include the claimed feature. The motivation of doing so would provide optimized page-based documents without causing an excessive delay before displaying a page, or portions of a page to the user (see col. 3, lines 34-38, Rowe).

Claims 1-8, 10-18 and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowe et al. (U.S. Patent no. 5,737,599) of record in view of DeRose et al. (U.S. Patent no. 5,557,722).

2. Regarding claims 1 and 11, Rowe discloses a computer-implemented method for annotating a system having a display for displaying a page having objects being intermixed with markup tags, the objects and the markup tags being stored in a non-modifiable portion of a file, the mark-up tags bounding the objects, comprising the steps of:

- receiving a designation of an object of the objects on the displayed page (see col. 16, lines 61-67, Rowe);
- receiving an annotation (see col.34, lines 5-30, Rowe);
- determining a position of the object in the non-modifiable portion of the file (see col. 7, lines 8-16; col. 11, lines 5-7; col. 12, lines 60-63 and col. 36, lines 39-44, Rowe)

regardless of the markup tags bounding the object (see col. 35, lines 42-50, Rowe).

There must be a view source page in the HTML document, it corresponds to the page having object with markup tags and it has to store in a non-modifiable portion;

- storing the position and the annotation separately from the non-modifiable portion of the file (see col.12, lines 48-59, Rowe).

Rowe, however, does not explicitly disclose “the annotation being modifiable”. DeRose, on the other hand, discloses this limitation (see col.23, lines 10-15, DeRose). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Rowe to include the step of modifying the annotation. The motivation of doing so would have been provide a useful aspects that a desired page are more quickly made available to the user (see col. 7, lines 43-45, Rowe).

3. Regarding claims 2 and 12, Rowe/DeRose combination further discloses that the object is received through interaction with a stylus (see col.10, lines 34-39, Rowe).
4. Regarding claims 3 and 13, Rowe/DeRose combination further discloses that the object is received through interaction with a mouse (see col.10, lines 34-39, Rowe).
5. Regarding claims 4 and 14, Rowe/DeRose combination further discloses that the annotation is a highlight (see col.12, lines 26-36, Rowe).
6. Regarding claims 5 and 15, Rowe/DeRose combination further discloses that the annotation is a bookmark (see col.11, lines 49-56, Rowe).
7. Regarding claims 6 and 16, Rowe/DeRose combination further discloses that the annotation is a drawing (see col.32, lines 36-54, Rowe).

8. Regarding claims 7 and 17, Rowe/DeRose combination further discloses that the annotation is a text annotation (see col.32, lines 36-43, Rowe).
9. Regarding claims 8 and 18, Rowe/DeRose combination further discloses counting the number of bytes from the beginning of the non-modifiable portion of the file to the selected object (see col.35, lines 38-59, Rowe).
10. Regarding claims 10 and 20, Rowe/DeRose combination further discloses that annotation is an annotation of the object (see col. 39, lines 47-55, Rowe).
11. Regarding claims 21 and 23, A computer-readable medium having stored thereon data structures comprising:
  - a first data structure having non-modifiable content (see col. 38, line 47 to col. 39, line 7) the non-modifiable content including a plurality mark-up tags associated with an object for displaying a page (see col. 35, lines 38-50, Rowe). The HTML document corresponds to the page having object with markup tags and it is obvious that the “view source” in the HTML document is non-modifiable;
  - a second data structure having modifiable content, the second data structure including at least a third data structure having a file position indicator that references a file position (see col.37, line 66 to col. 38, line 28, Rowe) in the first data structure and a fourth data structure including an annotation (see col.39, lines 42-47 and 57-65).

Please note that the “first data structure” corresponds to “first object”.

Rowe, however, does not explicitly disclose “the annotation being modifiable”. DeRose, on the other hand, discloses this limitation (see col.23, lines 10-15, DeRose). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Rowe to include

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the step of modifying the annotation. The motivation of doing so would have been provide a useful aspects that a desired page are more quickly made available to the user (see col. 7, lines 43-45, Rowe).

12. Regarding claims 22 and 24, Rowe/DeRose combination further discloses that the annotation is relevant to the object at the file position (see col.5, lines 27-36 and col. 39, lines 57-65, Rowe).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh B Thai whose telephone number is 703-305-4883. The examiner can normally be reached on 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Hanh Thai   
Art Unit 2171  
September 17, 2003

  
UYEN LE  
PRIMARY EXAMINER  
AU 2171